

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark D. Ackerman et al.	Examiner:	Behrang Badii
Serial No.:	09/973,664	Group Art Unit:	3694
Filed:	October 9, 2001	Docket:	1565.039US1
Title:	SYSTEM AND METHOD FOR CONTROLLING ACCESS TO LICENSED COMPUTING PROCESSES VIA A CODIFIED ELECTRONIC LICENSE		

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

The applicant requests review of the final rejection in the above-identified application.  
No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated below:

*§112 Rejection of the Claims*

Claims 15-21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant objects to this rejection in that the Examiner has had ample opportunity throughout prosecution to raise any ambiguity or indefiniteness rejections and presenting this now is untimely and impermissible and raises issues with respect to improper motive.

Moreover, the Examiner only generally rejected the claims and did not point out any specific claim wording issue. Applicant believes this is inappropriate and does not provide the Applicant adequate notice to remedy the perceived problem. Applicant can only guess at what specifically is the concern of the Examiner and is questioning why the rejection is being raised so late in prosecution when it does not appear that the rejection is related to the last entered amendment. Applicant believes that these 112 rejections have to be raised on a first action if present with the claim language of the first action as this appears to have been the case here. The rejection is vague and is untimely and is suspect given that this case was already thrown out of appeal (via a restriction requirement) and back into prosecution by the Examiner once. Applicant appeals the Examiner's sense of fairness and respectfully requests that the Examiner

deal with real and substantive issues of the claims and not vague and untimely issues that appear to have no real rationale foundation.

Applicant notes for the record that claim 15 has not substantively changed during the course of the prosecution. Moreover, the prosecution history is extensive for this case. It appears that now on a Final, the Examiner is raising issues as to the purpose and intent of the claim and its language? Applicant respectfully submits that these issues should have been raised long before and are improperly raised now. Thus, the 112 rejections should be withdrawn and the substantive issues of the claims dealt with.

The rejection is also very confusing to the Applicant. The Examiner states that he does not know the purpose of the inclusion and exclusion identifier and then states that these things are well known in the art. Applicant does not understanding a few things with respect to this rejection. First, how is something not understood and at the same time well known (in the Examiner's opinion in the art). Second, whether a claim limitation is well known in the art is not the subject of a 112 rejection under the law, that issue is the subject of a 103 or 102 rejection. So, the comment about being well known is totally misplaced and inappropriate in the context of the 112 rejection.

What is Applicant to correct when the Examiner asserts that the "general wording of the claim is unclear?" Applicant believes there is an affirmative duty under the law and the MPEP for the Examiner to provide a specific and clear rationale for a 112 rejection and a general statement is not proper and does not provide adequate notice under the administrative procedure act for the Applicant to remedy the perceived problem. In fact, Applicant has no real notice as to what the issue is with claim 15. The Examiner raised it in an untimely fashion and then raised it in such a manner that the Applicant cannot remedy it by saying the wording is "generally unclear." Applicant respectfully asks what does "generally unclear" mean and how is Applicant to correct it? Applicant respectfully believes these actions of the Examiner are in violation of all known laws and regulations and yet it appears the Examiner can continue, in Applicant's opinion, to get away with it at the expense of the Applicant. For the record, Application respectfully would like all this formally recorded for appeal purposes and for any subsequent litigation that may ensue that is related to this matter. Applicant does not feel that the Examiner

has treated Applicant fairly in this process and in this particular case and Applicant wants the record to formally reflect this opinion of the Applicant.

The claim preamble clearly states that it is a “method for licensing external processes on a server.” This is not unclear, the method goes on to detail how the license is generated, how components detailed in the license are registered and then processed. The external processes reside on the server this is not ambiguous; furthermore, the license is generated pursuant to a customer order in accordance with a licensing schema. The customer order in combination with a license schema drives creation of the license for processes that reside on the server. The customer order is not ambiguous and is self-explanatory. Next, the claim clearly states that inclusion and exclusion identifiers are used for accepting or rejecting specific software commands or operations of the software product and that the license includes at least one exclusion identifier that rejects usage of some software commands or operations. These limitations were never identified by the Examiner in the extensive prosecution history of this case as being ambiguous or unclear and Applicant believes that they are not ambiguous and are in fact clear. Therefore, Applicant does not believe that any claim amendments are necessary for this case and that the rejections are improper and should be withdrawn.

#### §103 Rejection of the Claims

Claims 15-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Biddle et al. (U.S. 2002/0107809) in view of Clement et al. (U.S. 7,203,703). It is of course fundamental that in order to sustain an obviousness rejection that each and every claim limitation must be taught or suggested in the proposed combination of references.

Here, the Examiner asserts that use of exclusion and inclusion identifiers are well known in the art. Applicant notes that the Application was filed in 2001 and that the manner of using exclusion and inclusion identifiers within a license to selectively enable and disable features of a software product was not well known in the art and the Examiner has produced no evidence to the contrary. A carte blanche statement to this effect does not make it so and is not permissible under the law. Therefore, at the outset Applicant respectfully disagrees with the Examiner’s assertion that the inclusion and exclusion identifiers are well known in the art.

The Examiner cites a reference in Clement (column 9 lines 50-54) that have absolutely nothing whatsoever to do with what Applicant has claimed. The reference cited deals with using a search string for a search to include or exclude strings. This is similar to “AND NOT” and “AND” limitations in a search query. This does not teach or even remotely suggest activating or deactivating operations of a software product. In fact, it defies commons sense to suggest that it does. The reference does not provide a reasonable or common sense approach to rejecting the claims, and as such is not proper and should be withdrawn. The Clement reference is related to providing on-the-job performance support and is in no way related to software licensing. Recent changes in the obviousness laws did not totally throw out requirements that the references when combined have to be in some rational and common sense manner related or compatible with one another. The Clement and Biddle references are not related in any rationale manner and the teaching providing in Clement is in no way related to what Applicant has claimed in the claim 15.

As such the rejections of record should be withdrawn and the claims allowed. Applicant respectfully requests an indication of the same.

#### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to

pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### **CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (513) 942-0224 to facilitate prosecution of this application.

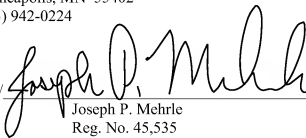
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date February 13, 2008

By /



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